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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/748,049	12/30/2003	David B. Olson	58907US002	6791

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EXAMINER
BERNSHTEYN, MICHAEL

ART UNIT	PAPER NUMBER
1713	

NOTIFICATION DATE	DELIVERY MODE
03/26/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<p align="center">Advisory Action Before the Filing of an Appeal Brief</p>	Application No. 10/748,049	Applicant(s) OLSON ET AL.	
	Examiner Michael Bernshteyn	Art Unit 1713	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 12 March 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
 b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ They raise the issue of new matter (see NOTE below);
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).


4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
 5. ☐ Applicant's reply has overcome the following rejection(s): _____.
 6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
 The status of the claim(s) is (or will be) as follows:
 Claim(s) allowed: _____.
 Claim(s) objected to: _____.
 Claim(s) rejected: 1-7, 9-13 and 19.
 Claim(s) withdrawn from consideration: 8, 14-18 and 20-22.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
 12. ☒ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). 03/15/2007
 13. ☐ Other: _____.


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 SUPERVISORY PATENT EXAMINER
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Continuation of 11.

Applicants contend that in accordance with 37 CFR 1.57(b) and (c), "essential material" may be incorporated by reference, but only by an incorporation by reference to a U.S. patent." The amendment to the specification requested to p. 11 of Applicant's specification in the response submitted November 20, 2006 complies with 37 CFR 1.57(f). The Applicant submits that the insertion of the phrase "solvent-free" on p. 11 is material previously incorporated by reference and therefore this amendment contains no new matter (page 2, 2nd paragraph).

It is noted that according MPEP 619.03 "Any correction inserting material by amendment that was previously incorporated by reference must be accompanied by a statement that the material being inserted is the material incorporated by reference and the amendment contains no new matter. 37 CFR 1.57(f)." There was no such statement in the received papers when the amendment was made after non-final rejection. Additionally, only "essential material" can be incorporated by reference. Applicants did not make any provention that "solvent-free" is "substantial material" for the polymerizable composition. As instant claim 1 recites, the term "consisting essentially of" concerning only the reaction product of the polymerizable composition, but not "solvent-free".

Applicants contend that coating a prism, however, is not the same as making prisms from such polymerizable compositions, as set forth in independent claim 1. When a prism is coated, only the coated surface of the prism consists of such composition. However, when prisms are prepared from a polymerizable composition, the entire prism consists of such composition (page 3, 2nd paragraph).

In response to applicant's arguments, the above recitation has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Applicants contend that although Williams and Martens are analogous art references, Olson et al. is not an analogous art reference. There is no motivation based on the references themselves to remove the solvent from the ceramer coating compositions of Olson et al. and then employ such compositions in the cast and cure process, such as described in Williams and Martens (and Lu).

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

It is noted that all three references are analogous art because they are from the same field of endeavor concerning new polymerizable compositions for optical articles.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate optical layer having a linear array of regular right prisms as taught by Williams in Olson's polymerizable composition for optical articles and to obtain the polymerizable composition as solvent-free as taught by Martens because of the following: 1) a linear array of regular right prisms is preferred for both optical performance and ease of manufacture (US'800, col. 2, lines 50-52), 2) use of solvents require a long time to evaporate, long cure cycles, curable materials which have a limited "pot" life, or result in replicated articles having limited toughness and dimensional stability and with severe shrinkage (US'850, col. 2, lines 4-8), and thus to arrive at the subject matter of instant claim 1 and dependable claims 2-7 and 9-13.

It is further noted that "The motivation in the prior art to combine references does not have to be identical to that of the applicant to establish obviousness, i.e. it is not required for a finding of obviousness that motivation of the skilled artisan be the same as an applicant motivation", *In re Kemps*, 97 F.3d 1427, 1430, 40 USPQ2d 1309, 1312 (Fed. Cir. 1996) (holding there is sufficient motivation to combine teachings of prior art to achieve claimed invention where one reference specifically refers to the other). Therefore, it is well settled that for a finding of obviousness under § 103 the prior art need not disclose the same motivation as disclosed by an applicant.

In the light of the discussion above the rejection of claims 1-7, 9-13 and 19 cannot be withdrawn and remains in force.